

## REMARKS

(1) Summary of the Office Action

Claims 1 to 77 are currently pending in this application.

The present application is a continuation of U.S. Patent Application Serial No. 09/568,202 filed on May 10, 2000, now issued to U.S. Patent No. 6,237,776, which in turn is a continuation of U.S. Patent Application No. 09/122,088, filed July 24, 1998, now issued to U.S. Patent No. 6,092,661.

In the Office Action dated October 30, 2001 in connection with the present continuation application, claims 1 and 2 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 3 and 4 of U.S. Patent No. 6,029,661 in view of U.S. Patent No. 5,217,119 to Hollingsworth. Claims 4-37, 46, 56, 57, and 62 to 64 were also rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-42 of U.S. Patent No. 6,237,776 in view of Hollingsworth. The Examiner has requested that a terminal disclaimer be filed to overcome the obviousness-type double patenting rejections. The Office Action has indicated that claims 43, 44, 46 and 57 would be allowable if rewritten in independent form including the features of the base claims and any intervening claims. The Office Action has further indicated that claims 1-35 would be allowable if such a terminal disclaimer were submitted.

Claims 51-55 and 66-68 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. More specifically, the Office Action has taken the position that claim 51 is inaccurate because the recited sidewall is not entirely



cylindrical. The Office Action also contends that claims 66-68 are indefinite because the quick release hook element and strap are not attached to the leading portion of the sidewall as recited in claim.

Claims 36, 45, 47, 49, 51-52, 55, 56, 60 and 62-64 were rejected as being unpatentable over U.S. Patent No. 4,537,313 of Workman in view of Official Notice.

Claims 37-42, 58 and 72-76 were rejected as being unpatentable over Workman in view of Official Notice and further in view of US. Design Patent No. 387,198 of Lehmann.

Claims 48 and 61 were rejected as being unpatentable over Workman in view of Official Notice and further in view of US. Patent No. 3,915,304 of Pasco.

Claims 51-53, 55 and 64-68 were rejected as being unpatentable over Workman in view of Official Notice and further in view of US. Design Patent No. 371,942 of Lippincott.

Claim 50 was rejected as being unpatentable over Workman in view of Official Notice and further in view of US. Patent No. 5,884,768 of Fox.

Claim 54 was rejected as being unpatentable over Workman in view of Official Notice and further in view of Lippincott and US. Patent No. 5,934,527 of Von Neumann.

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Claim 69 was rejected as being unpatentable over Workman in view of Official Notice and further in view of US. Patent No. 4,767,039 of Jacober.

Claim 70 was rejected as being unpatentable over Workman in view of Official Notice and further in view of Jacober and US. Patent No. 4,378,866 of Pelavin.

Claim 59 was rejected as being unpatentable over Workman in view of Official Notice and further in view of Fox.

Claim 71 was rejected as being unpatentable over Workman in view of Official Notice and further in view of Jacober and US. Patent No. 5,288,150 of Bearman.

Claim 77 was rejected as being unpatentable over Workman in view of Official Notice and further in view Lehmann and Bearman.

(2) **Amendments to the Claims**

Claims 4, 50-52, 54, 55, 64-66 (now 65-67) and 68, 70, 71 and 73-77 have been amended by the present response.

Claim 4 has been amended to recite that the sidewall member is arcuate such that, when viewed from above, the sidewall member has a D-shaped cross-section. This feature is clearly shown in the Figures. Accordingly, the amendment introduces no new subject matter.



Claim 50 has been amended to change its dependency. Claim 50 as originally filed depended from claim 65. As presently amended, claim 50 now depends from base claim 36.

Claims 51, 52, 54 and 55 have been amended to remove any reference to the sidewall being cylindrical. In addition, claim 51 has been amended such that it now recites that the sidewall has a constant cross-section.

Claim 64 (now claim 65) has been amended to particularize that the first lifting member is carried on the leading portion. Claim 65 (now claim 66) has been amended to recite that the second lifting member is carried on the leading portion of the sidewall. Claim 66 (now claim 67) has been amended to particularize that the first lifting member is carried higher on the leading portion of the sidewall than the second lifting member.

Claims 68, 70, 71 and 73-77 were amended to maintain consistent dependencies based on the renumbered claims.

In light of the foregoing amendments made to claims 51, 52, 54, 55 and 64-66 (now 65-67), the applicant respectfully submits that the indefiniteness rejections made by the Office Action are now moot.

The amendments made to the claims are shown in the attached sheet entitled **"MARKED-UP COPY OF ORIGINAL CLAIMS 4, 50-52, 54, 55 AND 65-68, 70, 71 and 73-77"**.

(3) **Claim Rejections based on Non-Statutory Double Patenting**

As requested in the Office Action, the applicant submits concurrently with the present response a terminal disclaimer for the instant application in respect of each of U.S. Patent No. 6,092,661 and U.S. Patent No. 6,237,776.

(4) **Claim Rejections under U.S.C. 103(a) – Obviousness**

(a) **Statement of the Law - Obviousness**

**Basic Requirements of a *Prima Facie* Case of Obviousness**

**Section 2143** of the Manual of Patent Examining Procedure (MPEP) states:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir 1991).

**Reliance on Common Knowledge in the Art or “Well Known” Prior Art**

**Section 2144.03** of the Manual of Patent Examining Procedure (MPEP) states:

“The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well known” prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being “well known” in the art.

... For further view on official notice, see *In re Ahlert*, 424 F.2d 1088, 1091 [additional citation omitted] (“[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work” and “allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported.” Furthermore



the applicant must be given the opportunity to challenge the correctness of such assertions and allegations. "The facts so noticed serve to 'fill gaps' which might exist in the evidentiary showing" and should not comprise the principle evidence upon which a rejection is based.)

....  
**In re Enyde**, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973)  
("The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of [judicial] notice.") [underline and bold added by applicant for emphasis.]

(b) **Arguments concerning rejections based on 35 U.S.C. 103 - Obviousness**

**Re: Workman & Official Notice**

The Office Action asserts that claims 36-42, 45-56 and 57-77 are unpatentable over Workman in view of Official Notice alone, or in combination with, other cited references. The applicant respectfully traverses these rejections and requests that these rejections be withdrawn for the following reasons: (1) the Office Action has not met the requirements listed above to establish a *prima facie* case of obviousness; and (2) the Office Action has improperly applied Official Notice to recognize facts which are, in fact, not capable of instant and unquestionable demonstration as being "well known" in the art.

**Claim 36**

In respect of applicant's claim 36 the Office Action states that: "Workman discloses all of the elements of the claims, but does not show the D-shape as recited in claims 36 and 56..." The Office Action further states that "Official Notice is taken of conventional design to provide a container in a variety of desire[d] shapes... It would have been obvious in view of Official Notice to provide the desire[d] shape and reinforcements for the container of Workman to attract [the] buyer and strengthen the container."



The applicant respectfully submits that, contrary to the Office Action's assertions, Workman does not disclose all of the elements of the claim, but for the D-shape cross-section of the sidewall. As explained below, Workman is, in fact, missing several features of the sidewall claimed in claim 36.

Workman describes a portable, soft, insulated bag composed of a front panel 10, side panels 12 and 14, a top opening panel 16, back panel 18 and a bottom panel. As can be seen in Figures 1 and 2, the panels 10, 12, 14 and 18 are generally rectangular in shape and are arranged in a box-like configuration. In this arrangement, each of front panel 10 and back panel 18 has a pair of long sides and a pair of short sides. The long sides of panels 10 and 18 are oriented so that the panels are wider than they are tall. This is contrary to the feature recited in the applicant's claim 36. Applicant's claim 36 claims a sidewall which has a height greater than its breadth, that is, a sidewall than is taller than wide.

In addition, applicant's claim 36 recites a sidewall having a second portion that is arcuate. None of the panels 10, 12, 14 and 18 of Workman's insulated bag appears to have an arcuate portion. The specification of Workman neither describes nor suggests providing any of these panels with an arcuate portion. In light of the foregoing, the applicant respectfully submits that Workman does not teach all of the features of the claimed invention of claim 36 and accordingly, the Office Action has not met the requirements for a *prima facie* case of obviousness.



In regard to the use of Official Notice to reject claim 36 on the basis of obviousness, the applicant respectfully submits that the Office Action has made an improper and impermissible use of Official Notice for the reasons set out below.

(i) According to U.S. Patent Law, Official Notice may be taken of facts outside the record which are capable of instant and unquestionable demonstration as being "well known" in the art. In the present application, the Office Action has taken Official Notice of conventional design to provide a container in any variety of desired shapes. However, in so doing the Office Action has recognized a feature which, in the applicant's view, is: (a) not capable of being instantly shown to be well known in the art; and (b) not part of conventional design for coolers.

In particular, Official Notice has been used to recognize the feature of the sidewall having a D-shaped cross-section. However, this feature is not taught in the prior art. None of the cited references describe, show or otherwise suggest providing a cooler with a sidewall having a D-shaped cross-section. Accordingly, Official Notice cannot be used to take notice of this feature since it may only be used in connection with facts that are capable of instant and unquestionable demonstration as being "well known" in the art. Clearly, this feature is not known in the art.

(ii) In any event, the use of Official Notice to take notice of facts which constitute the state of the art is not permissible. The Court of Customs and Patent Appeals in *In re Enyde, Pollet and De Cat, supra*, specifically rejected the notion that judicial or administrative notice may be taken of the state of the art. The Court explained the



rationale for this finding in the following manner: "The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of [judicial] notice."

(iii) In addition, in the present instance, Official Notice has gone beyond what has been stated in *re Ahlert*, supra as "[filling in the] gaps which might exist in the evidentiary showing made in the Office Action to support a particular ground of rejection." The Office Action has essentially predicated the rejection of claim 36 on Official Notice using the latter to recognize the feature of the sidewall having a D-shaped cross-section. The MPEP has cautioned against the application of Official Notice in this manner. More particularly, the MPEP has stated that Official Notice "should not comprise the principle evidence upon which a rejection is based"(underline added for emphasis).

(iv) The Office Action has not supported its taking of Official Notice to recognize the feature of the D-shaped cross-section of the sidewall with any specific citation of a reference, as required by law. In this regard, *in re Ahlert*, supra, states that "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should [also] be supported." The Office Action has taken Official Notice of conventional design to provide a container in a variety of desired shapes, but has not furnished a specific reference showing a cooler having a sidewall that has a D-shaped cross-section. Accordingly, the applicant respectfully requests that the Office Action set forth a specific reference showing that claimed feature so that the applicant may be given the opportunity to challenge the correctness of the Office Action's assertions and allegations.

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Dependent Claims 37 -55

The applicant states the foregoing not only in respect of claim 36, but also in respect of claims 37 to 55 that depend from claim 36. Accordingly, the applicant respectfully submits that claims 37 to 55 are allowable over Workman alone, or in combination with any of the prior art cited by the Office Action.

Claim 56 -77

In the context of claim 56 and claims 57 to 77 depending therefrom, the applicant repeats the foregoing arguments to the extent applicable. Accordingly, the applicant respectfully submits that claims 56 to 77 are allowable over Workman alone, or in combination with any of the prior art cited by the Office Action.

(7) Conclusion

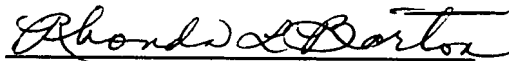
In view of the foregoing arguments and amendments the applicant submits that all of claims 1 to 77 are presently allowable over the art of record in the case. Accordingly, the Applicant respectfully requests allowance of claims 1-77 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.



In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300.

Respectfully submitted,



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Enclosures: Marked-Up Copy of Original Claims 4, 50-52, 54, 55,  
65-68, 70, 71 and 73-77  
Petition for Extension of Time (2 months)  
Submission of Terminal Disclaimers (2)  
Check No.337512

**MARKED-UP COPY OF ORIGINAL CLAIMS 4, 50-52, 54, 55,**

**65-68, 70, 71 and 73-77**

4. (Amended) An insulated pack comprising:

a flexible, soft shell wall structure having a flexible insulated layer, and having a bottom portion, a top portion, and a sidewall member;

said sidewall member having a leading portion, a trailing portion and left and right hand side portions;

said leading, trailing and left and right hand side portions extending between said top and bottom portions;

said portions of said soft shell wall structure co-operating to define therewithin an insulated compartment;

said top portion including a lid, said lid being moveable to an open position to give access to said insulated compartment;

said sidewall member having a height and a breadth, said height being greater than said breadth, and said trailing portion being arcuate such that, when viewed from above, said sidewall member has a D-shaped cross-section;

a liner mounted within said compartment to receive objects introduced when said lid is in said open position, said liner being moveable to an inverted position to facilitate washing thereof;

a lifting member attached to said sidewall member; and

a secondary wall structure mounted to said trailing portion of said sidewall member, said secondary wall structure standing outwardly of said trailing portion of said sidewall member and defining an auxiliary compartment therewithin; said secondary wall structure having an auxiliary compartment closure member operable to give access to said auxiliary compartment.

50. (Amended) The cooler according to claim [65] 36, wherein said top has a handle mounted thereon and is moveable to a closed position relative to said insulated compartment; and when said top is in said closed position, said cooler can be carried by said handle.

51. (Amended) The cooler according to claim 36, wherein:

said sidewall [~~is cylindrical~~] has a constant cross-section;

said first portion of said sidewall is a leading portion of said sidewall;

said second portion of said sidewall includes a trailing portion, a right hand side portion and a left hand side portion of said sidewall; and

said sidewall has at least one lifting member attached thereto.

52. (Amended) The cooler according to claim 51, wherein said [~~cylindrical~~] sidewall has a lifting member attached to said leading portion of said [~~cylindrical~~] sidewall.

54. (Amended) The cooler according to claim 52, wherein said [~~cylindrical~~] sidewall has a fastener member mounted to said leading portion of said [~~cylindrical~~] sidewall; said fastener member being operable to inhibit swaying of said cooler relative to said quick release fitting when suspended thereby.

55. (Amended) The cooler according to claim 51, wherein said [~~cylindrical~~] sidewall has left hand side and right hand side lifting members attached, respectively,



to said left hand side portion and right hand side portion of said ~~[cylindrical]~~  
sidewall.

65. (Amended) The cooler according to claim 56, wherein said sidewall has a first, leading portion and a second, trailing portion, said trailing portion being arcuate when viewed from above, and a lifting member is ~~[mounted to]~~ carried on said leading portion.

66. (Amended) The cooler according to claim [64] 65, wherein a second lifting member is also ~~[attached to]~~ carried on said leading portion of said sidewall.

67. (Amended) The cooler according to claim [65] 66, wherein said first lifting member is ~~[mounted]~~ carried higher on said leading portion of said sidewall than said second lifting member.

68. (Amended) The cooler according to claim [66] 67, wherein said first lifting member is a quick release hook, and said second lifting member is a cinch strap.

70. (Amended) The cooler according to claim [68] 69, wherein said pocket has a slanted opening.

71. (Amended) The cooler according to claim [68] 69, wherein said pocket has a see through mesh web member.

73. (Amended) The cooler according to claim [71] 72, wherein:

said secondary wall structure has first and second side portions extending vertically along, and standing outwardly of, said arcuate portion of said cylindrical wall;

said secondary wall structure has an intermediate wall extending between said first and second side portions of said secondary wall structure; and

said intermediate wall has a lower portion and an upper portion; said upper portion has a flap, said flap being releasable along a margin thereof to give access to said auxiliary compartment.

74. (Amended) The cooler according to claim [72] 73, wherein a pocket is mounted to said lower portion of said intermediate wall of said secondary wall structure.

75. (Amended) The cooler according to claim [72] 73, wherein said pocket has a horizontal uppermost edge.

76. (Amended) The cooler according to claim [72] 73, wherein said pocket has a zipper mounted along said uppermost edge.

77. (Amended) The cooler according to claim [72] 73, wherein said pocket includes a see-through mesh web.

